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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1941.

No. 720

MILCOR STEEL COMPANY,
Petitioner,

vs.

GEORGE A. FULLER COMPANY, NEFF LATHING COMPANY, INC., and CONVER STEEL & WIRE COMPANY, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI
AND
BRIEF IN SUPPORT THEREOF.

GEORGE L. WILKINSON,
ASHER BLUM,
Counsel for Petitioner.

Eastman Bros., Law Printers, 542 S. Dearborn St., Chicago

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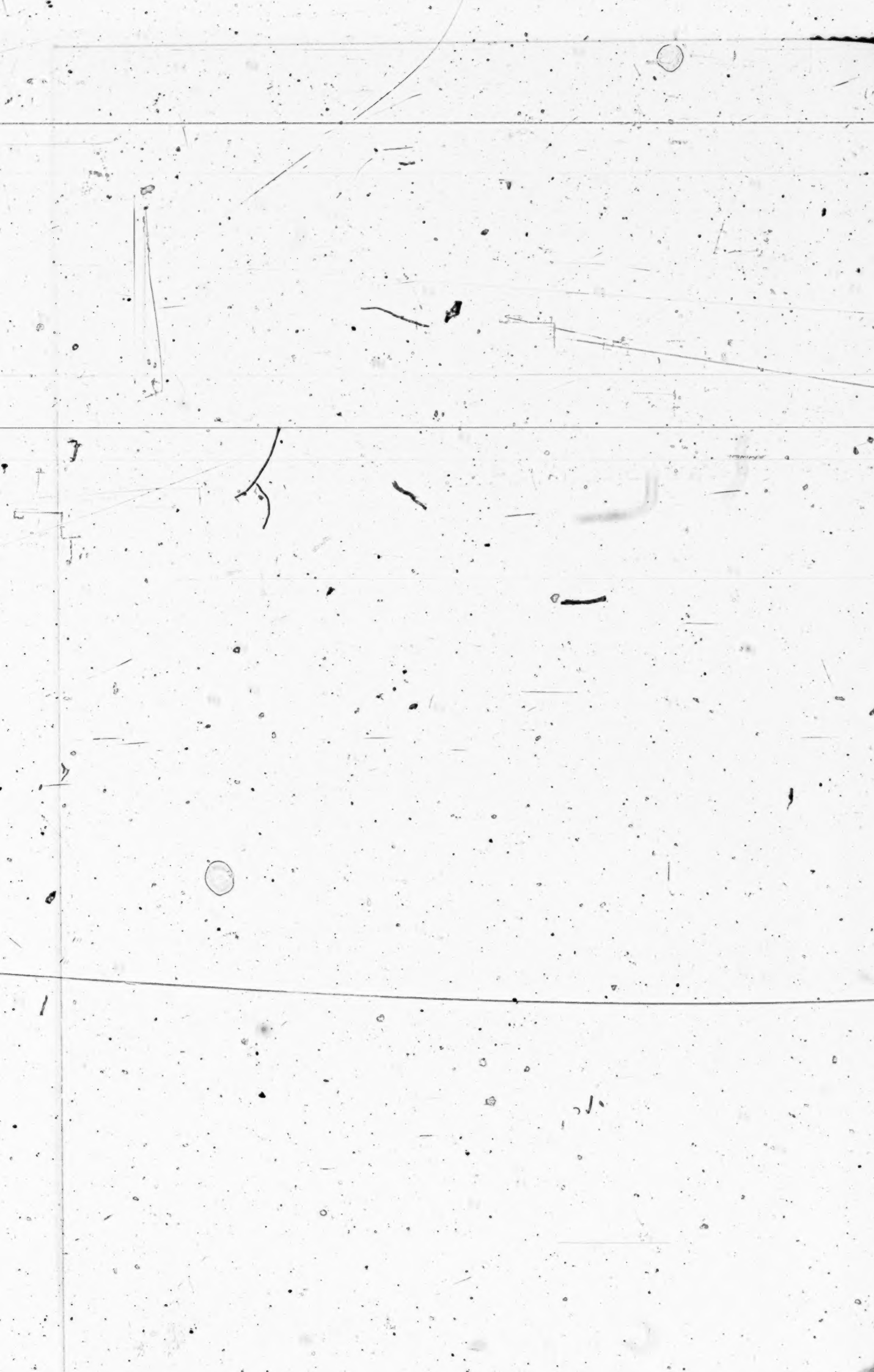

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Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associated Justices of the Supreme Court of the United States:

Your petitioner, Milcor Steel Company, prays that a writ of certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Second Circuit entered July 31, 1941 (R. 165), reported in 122 Fed. (2d) 292.

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith, in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved.

This is a suit brought by petitioner against respondents for infringement and contributory infringement of petitioner's Holdsworth patent No. 2,105,770, issued January 18, 1938, for Wall Construction (R. 47). The complaint (R. 3) was filed on June 22, 1939. On November 29, 1939, petitioner advised respondents' attorneys (R. 15) that a disclaimer (R. 16) had been filed in the United States Patent Office as to the claims at issue, namely, Claims 6 and 7 of the Holdsworth patent in suit.

On October 8, 1940, a motion (R. 22) was filed on behalf of the respondents for a judgment on the pleadings under Rule 12(c), or an alternative, for a summary judgment under Rule 56, of the Rules of Civil Procedure for the District Courts of the United States. On December 2, 1940, the District Court filed an opinion (R. 41), holding that the disclaimer as to Claims 6 and 7 of petitioner's patent rendered the said claims invalid in view of the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and thereafter on December 18, 1940, a judgment (R. 42) was entered pursuant to the said opinion, dismissing the complaint on the ground that Claims 6 and 7 of the patent in suit were invalid and void by reason of improper disclaimer.

An appeal was duly taken by petitioner to the United States Circuit Court of Appeals for the Second Circuit, and on July 31, 1941, the said Court affirmed the judgment of the District Court, although recognizing that in doing so it was in conflict with the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits in its interpretation and application of the said decision of this Court in the said Altoona decision.

Jurisdiction.

1. This is a suit arising under the Patent Laws of the United States, Judicial Code, Sec. 24 (7) (28 U. S. C. Sec. 41 (7)).

2. The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925 (28 U. S. C., Sec. 347).

3. The date of the judgment which petitioner seeks to have reviewed is July 31, 1941.

Questions Presented.

The decision of the Circuit Court of Appeals for the Second Circuit presents the following questions:

1. Is the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, correctly interpreted and applied in the instant case, or in the judgments in conflict therewith of the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits?

2. Is the decision correct in holding that every disclaimer which does not surrender a whole claim, necessarily adds a new element, and hence is invalid?

3. Does the disclaimer statute (U. S. Rev. Stat. Sec. 4917; U. S. C. Title 35, Sec. 65) permit a patentee who "has claimed more than that of which he was the original and first inventor," to render his patent "valid for all that part which is truly and justly his own," by defining more specifically an element of the claimed structure, thereby relinquishing a broad invention, which he did not invent, and preserving a limited invention, which he did invent?

Reasons for Granting the Writ.

The following grounds which are suggested in Rule 38 of this Court:

The Circuit Court of Appeals for the Second Circuit has rendered a judgment:

1. Which it frankly admits is in conflict with judgments of the Seventh, Ninth and Sixth Circuit Courts of Appeals in *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 Fed. (2d) 938; *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 Fed. (2d) 823; *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 87 Fed. (2d) 783, and *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*, 111 Fed. (2d) 239.

2. Which decides a Federal question in a way probably in conflict with the applicable decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477.

3. Which decides an important question of Federal law which has not been, but should be, settled by this Court.

4. Which decides a question relating to the construction and application of a statute of the United States (Rev. Stat. Sec. 4917, U. S. C. Title 35, Sec. 65).

Wherefore, it is respectfully submitted that this petition for writ of certiorari to the Circuit Court of Appeals for the Second Circuit should be granted.

George L. Wilkinson,
Asher Blum,
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the United States District Court for the Southern District of New York was filed December 2, 1940 (R. 41), and the judgment entered pursuant thereto (R. 42) on December 18, 1940.

The opinion of the Circuit Court of Appeals for the Second Circuit was filed July 31, 1941. It is reported in 122 Fed. (2d) 292.

Specification of Errors.

The errors which petitioner will urge if the writ of certiorari is issued are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding that a disclaimer adds a new element to a claim when it makes more specific an already present element.

2. In construing the decision of this Court in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, differently from the construction which has been placed upon it by the Sixth, Seventh and Ninth Circuit Courts of Appeals.

3. In holding that the disclaimer statute only permits the surrender of a whole claim and not the restriction of a broad claim by limiting an element thereof by specifying that it comprises certain structural characteristics.

Summary of Argument.

1. The Circuit Court of Appeals for the Second Circuit correctly states that its decision is in conflict with the decisions of the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits (R. 161).

2. The disclaimer as to Claims 6 and 7 of the patent in suit added (a) no new elements to those originally present in said claims, and (b) did not transform "the patent originally for one combination," "into a new and different one."

3. The disclaimer statute "affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent" (*Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477), and should be liberally interpreted to accomplish its intended purpose.

ARGUMENT.

Point 1.

The Circuit Court of Appeals for the Second Circuit in the instant case frankly states that its interpretation and application of the decision of this Court in the *Altoona* case is in conflict with decisions rendered by other Circuit Courts of Appeals, as follows:

> ". . . It is true that the Seventh Circuit in *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 Fed. (2) 937, and the Ninth—by a divided court—in *Payne Furnace & Supply Co.* v. *Williams-Wallace Co.*, 117 Fed. (2) 823, have attempted to make a distinction, but with deference we cannot understand the reasoning. The Sixth Circuit has also twice sustained such disclaimers since the *Altoona* case was decided (*Byrne Mfg. Co.* v. *American Flange Mfg. Co.*, 87 Fed. (2)

Jan. 18, 1938. H. HOLDSWORTH 2,105,770

WALL CONSTRUCTION

Filed Oct. 15, 1936

Fig. 1.

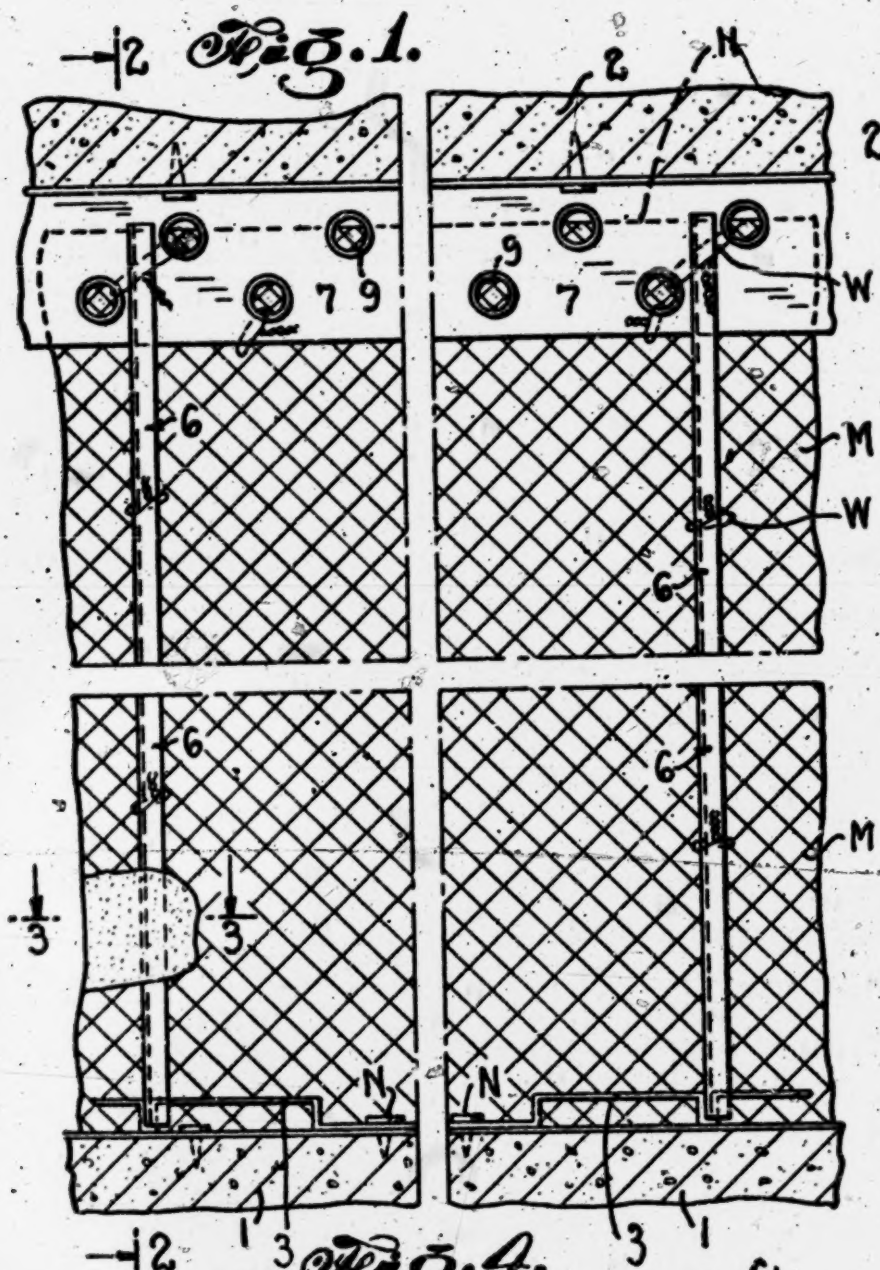


Fig. 2.

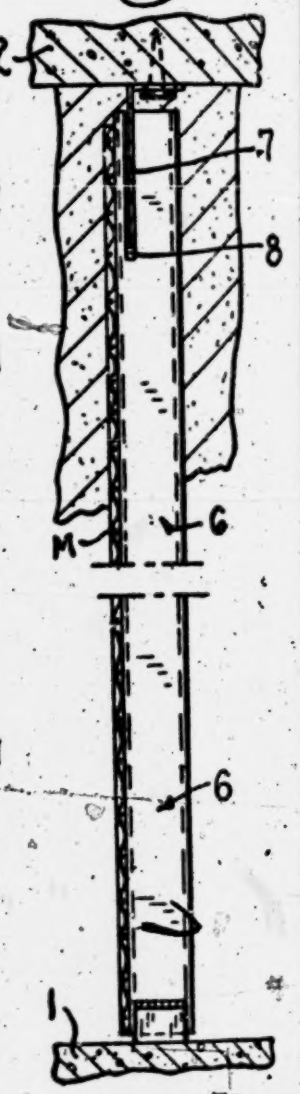


Fig. 4.

Fig. 5.

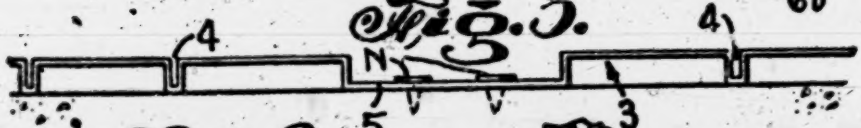


Fig. 6.

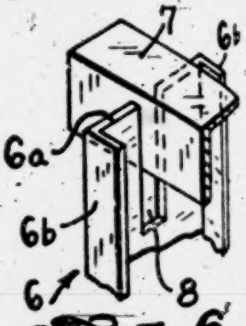
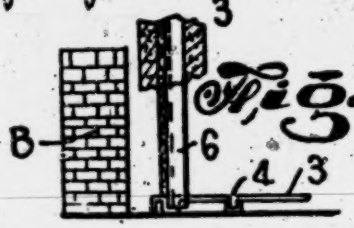


Fig. 3.

Fig. 7.



INVENTOR.
Harry Holdsworth
BY
Mock & Blum
ATTORNEYS.

783; *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*; 111 Fed. (2) 239) but, strangely enough, it did not mention that decision either time, though we are assured that the defendants urged it in their briefs. Perhaps the Sixth must therefore be added to the other two; but in any event the Supreme Court alone can declare what is the present law on the subject'' (R. 165).

That the Circuit Court of Appeals was correct in stating that its judgment differs from the decisions of the said other Circuit Courts of Appeals, clearly appears from a comparison of the disclaimer as to the patent in suit in the instant case, which has been held invalid in view of the decision of this Court in the *Altoona* case, with the disclaimers as to certain claims in the patents at issue in the decisions of the Circuit Courts of Appeals for the Sixth, Seventh and Ninth Circuits, which were held valid and not within the principle announced by this Court in the *Altoona* case.

Point 2.

Holdsworth Patent in Suit No. 2,105,770 (R. 747).

For convenient reference, the drawing of the patent in suit is here reproduced.

The specification (R. 48) states that the objects of the invention are to provide "an improved construction which can be used for constructing interior walls or partitions between rooms or which can also be used for constructing the furring of the exterior wall of a building"; "improved means for supporting metal lath or the like, for serving as a support for the plaster"; "a construction whereby the channels or other supporting members are held at their base against movement in any direction, and the upper ends of said channels or other supporting members are held so as to limit a turning movement in a direction parallel to the front or main wall of the channel," and "a structure which could be readily installed at minimum cost."

A base member 3 provided with spaced depressions 4 is suitably connected to the top surface of the floor 1. A ceiling member 7 of angular shape, having a perforated depending flange, is secured to the ceiling of the room in vertical alignment with the base 3. Vertical channel shaped wall supports 6 are supported at their lower ends in the recesses 4 in the base member 3, and are provided with vertical slots at their upper ends to receive the depending perforated flange of the ceiling member 7. The channel wall supports are of slightly less height than the distance between the floor and ceiling of the room so that when the slots 8 therein are engaged with the depending flange of the ceiling member they may be moved vertically a sufficient distance to engage their lower ends with the recesses in the base member 3. The upper ends of the wall supports 6 extend between adjacent perforations in the depending flange of the ceiling member, and are prevented from longitudinal movement by the burrs around the perforations. The lower ends of the wall supports 6 are securely retained against movement relative to the base member 3 through

the engagement of the web of the channel members in the recesses in the base member with their flanges, or side walls, snugly abutting the side surfaces of the base member adjacent the recesses therein.

After the base member 3 and the ceiling member 7 have been secured in vertical alignment to the floor and ceiling respectively, the wall supports 6 are readily placed in position by engaging the slots 8 in their upper ends with the depending flange of the ceiling member 7 between adjacent perforations therethrough, and then elevating them slightly so that their lower ends may be in position to drop into the recesses 4 in the base member. Any suitable metal lathing M may then be secured to the wall support 6, with its upper edge lapping the depending flange of the ceiling member 7, and plaster then applied to the lathing.

The disclaimer as to Claim 6 reads as follows:

> "As to claim 6, except a wall construction for a room in which the ceiling member comprises a vertical depending perforated flange, one side of which is overlapped by metal lathing" (R. 51).

For convenient reference, Claim 6 is printed here with the limitation added by disclaimer italicized:

> "6. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member *comprising a vertical depending perforated flange, one side of which is overlapped by metal lathing,* said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, and means operative to prevent any substantial tilting movement of said wall supports from their predetermined upstanding position" (R. 50).

Claim 6, originally and as limited by the disclaimer, defines a wall construction comprising certain specified elements, namely, a base member, a ceiling member, upstanding wall supports, and means operative to prevent substantial tilting movement of the wall supports from their predetermined upstanding position, and defines their structural characteristics and their cooperative relationship.

The disclaimer limits or restricts the "ceiling member" by specifying that it comprises "a vertical depending perforated flange, one side of which is overlapped by metal lathing." The disclaimer does not add metal lathing as a new physical element to the combination claimed, but merely refers to it in connection with the already present element, "ceiling member," to limit the same to one which comprises a vertical depending perforated flange, having the characteristic of being overlapped by metal lathing.

The specification and drawing of the Holdsworth patent disclose the wall construction embodying the invention as comprising a ceiling member having a vertically depending perforated flange (page 1, line 35 *et seq.*), which is overlapped by the metal lathing (page 2, line 33 *et seq.*). Consequently, Claim 6 as limited by the disclaimer is for the same combination previously claimed, and is not transformed into a new and different combination.

The drawings and description of the Holdsworth patent disclose only a single embodiment of the invention, in which the "ceiling member" has the shape and relation to the metal lathing, specified in the disclaimer. The more specific description of the ceiling member did not add a new mechanical element. On the contrary, it made more specific, a mechanical element already in the claim. For example, let us assume that the first man who originated a knife which had a blade and a handle had secured a patent

thereon, and that the drawings showed that the blade had a point. If the claim broadly specified the combination of a blade and a handle, it would not be adding a new mechanical element to state, by way of disclaimer, that the blade was shaped so as to have a point.

The disclaimer as to Claim 7 is as follows:

> "As to claim 7, except a wall construction for a room in which the base member is composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses" (R. 51).

For convenient reference, Claim 7 is printed here with the limitation added by disclaimer italicized:

> "7. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, said base member *composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses,* and said ceiling member being shaped to provide means which are operative to prevent any substantial tilting of said wall supports from their predetermined upstanding position" (R. 50).

The base member, which is an element of Claim 7 in its original form, is more specifically defined by the disclaimer as "composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports," and the shape of the wall supports, which are an element of Claim 7 in its original form, are specifically

defined as of channel form, the flanges of which overlap t
base member adjacent the recesses therein.

The drawings and specification explicitly describe the i
vention of Holdsworth as residing in a wall constructi
comprising a base member and channel wall supports ha
ing the characteristics to which they are limited by t
disclaimer (page 1, line 10 *et seq.*).

This Court, in its decision in the *Altoona* case, in vi
of which the Circuit Court of Appeals held Claims 6 an
of the Holdsworth patent in suit to have been render
invalid by the disclaimers filed as to them, said (pa
489, 490):

> "While the effect of the disclaimer, if valid, was
> one sense to narrow the claims, so as to cover the co
> binations originally appearing in Claims 9 and 13 o
> when used in conjunction with a flywheel, it also *op*
> *ated to add the flywheel as a new element to each*
> *the combinations described in the claims.*"
>
> ". . . While this statute affords a wide scope
> relinquishment by the patentee of part of the pat
> mistakenly claimed, where the effect is to restrict
> curtail the monopoly of the patent, it does not per
> the addition of a new element to the combination p
> viously claimed, *whereby the patent originally for*
> *combination is transformed into a new and diffe*
> *one for the new combination.*" (Emphasis suppli

This Court in its said decision did not rule broadly t
an element could not be added to a combination claim
disclaimer, but merely held that it was improper to d
in a case where "the patent originally for one combina
is transformed into a new and different one for the
combination." . . .

The disclaimers to Claims 6 and 7 of the Holdsw
patent, even if they should be regarded as adding new
ments to the combinations previously claimed, did not tr
form the patent originally for one combination "into a

Oct. 28, 1924. 1,513,637

M. SCHWARTZ

BUSHING

Filed Aug. 17, 1923

Fig. 1

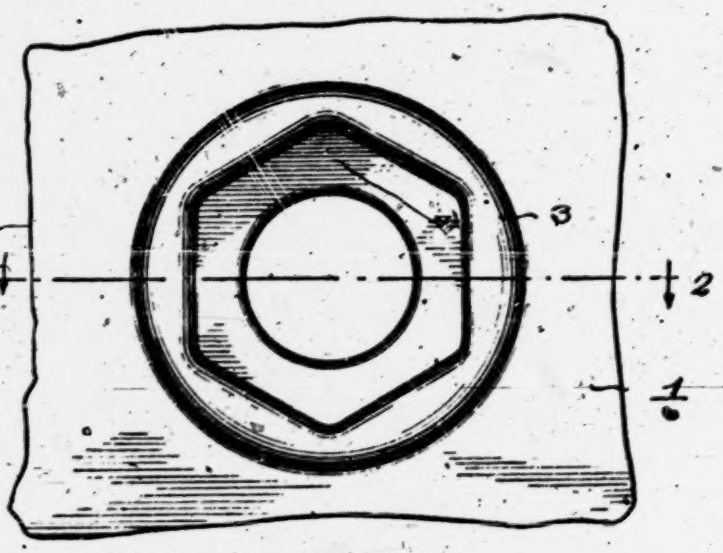


Fig. 2

Fig. 3

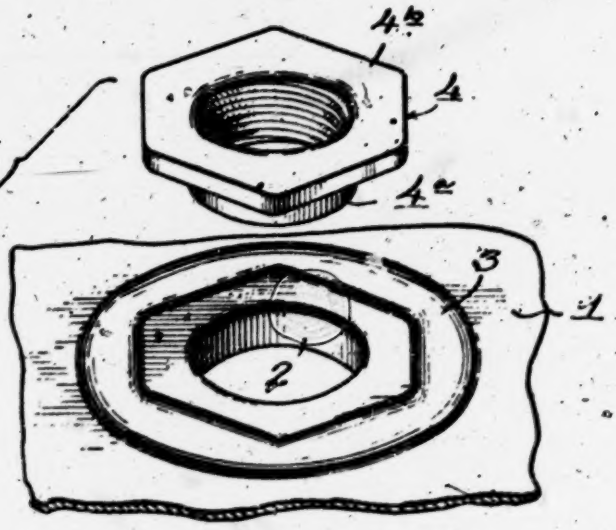
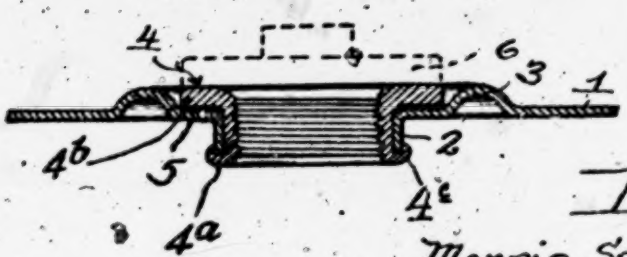


Fig. 4



Inventor,
Morris Schwartz,
By Offield Kobb Hunton & Swett

and different one for the new combination," inasmuch as the drawing and specification of the Holdsworth patent disclose the invention in a single embodiment of a wall construction, the elements of which are specifically those of Claims 6 and 7 as amplified by the disclaimer to them.

The decision of this Court in the *Altoona* case has been considered by several Circuit Courts of Appeals and District Courts, and has been construed as not rendering invalid disclaimers of the character of that in the instant case, with which decisions that by the Circuit Court of Appeals for the Second Circuit in the instant case is admittedly in conflict.

The Court of Appeals for the Sixth Circuit in *Byrne Mfg. Co.* v. *American Flange & Mfg. Co., Inc.*, 87 Fed. (2d) 783, decided January 12, 1937, had before it a patent to Schwartz, No. 1,513,637, for a Bushing, as to Claims 1 and 3 of which a disclaimer had been filed very similar to that filed as to Claims 6 and 7 of the Holdsworth patent. For convenient reference, we here reproduce the drawing of the said Schwartz patent.

The Schwartz invention relates to an annular bushing for metal containers. 1 indicates a portion of the metal wall of the container, with a hole therein surrounded by an annular flange or collar 2. A bushing or bung ring 4, comprising an internally threaded cylindrical portion 4*a*, is inserted in the hole in the metal container, and the lower edge of the cylindrical portion 4*a* of the bushing is curled around the lower edge of the collar 2 around the hole in the container wall, thereby tightly securing the bushing in position and against rotation with respect to the container by reason of the hexagonal perimeter 4*b* of the bushing engaging with a similar seat formed in the wall of the container around the hole therethrough. Claims 1 and 3 of the Schwartz patent, together with the disclaimer relating to them, appear in 87 Fed. (2d) page 784.

The disclaimer limited the support of Claim 1 to "a metal container having a hole in which the bushing is sealed by rolling the marginal portion of the bushing over, upon and around the edge of the annular flange surrounding the hole." The support, as well as the bushing, elements of original Claim 1, were respectively limited by the disclaimer to a metal container having an annular flange around the hole therethrough, and to a bushing having a marginal portion rolled around the edge of the annular flange surrounding the hole.

If the disclaimer herein is objected to, on the ground that it adds one or more additional elements to the claims, such objection applies with even greater force to the disclaimer to the Schwartz patent, because such disclaimer incorporated a reference to the rolled marginal portion of the bushing, and the association between this rolled marginal portion and the annular flange surrounding the hole.

The disclaimer to Claim 3 of the Schwartz patent limited the method covered thereby to one in which the step for sealing the ring within the hole in the metal container, com-

prised "rolling the marginal portion of the ring over, upon and around the edge of the angularly projecting annular flange surrounding the hole."

The record in the said case shows that the defendant attacked the validity of Claims 1 and 3 of the Schwartz patent on the ground that the disclaimer was improper in view of the previously rendered decision of the Supreme Court in the *Altoona* case. The Court of Appeals for the Sixth Circuit, however, in sustaining the claims as valid, said:

> "It is urged that this disclaimer enlarges the scope of claims 1 and 3 of Schwartz and is therefore invalid. We think otherwise. The disclaimer adds no new element. The effect of it as to claim 1 is to limit the engagement between the perimeter of the laterally projecting flange of the bushing and its seat to certain characteristics; and as to claim 3, to limit the sealing step of the bushing to the process of rolling the inner edge thereof, under, around, and over the edge of the annular collar surrounding the hole. See *Wood* v. *Peerless Motor Car Corp.*, 75 F. (2d) 554, 556 (C. C. A. 6); *N. O. Nelson Mfg. Co.* v. *F. E. Meyers & Bro. Co.*, 29 F. (2d) 968, 969 (C. C. A. 6)" (p. 784).

The Court of Appeals for the Sixth Circuit in a later case, *Cincinnati Rubber Mfg. Co.* v. *Stowe-Woodward, Inc.*, 111 Fed. (2d) 239, held valid certain claims as to which a disclaimer had been filed and which the defendant contended were rendered invalid thereby. The disclaimer as to Claim 1 of the Woodward reissue patent No. 18,111 there in suit will serve to illustrate that the court held valid a disclaimer similar to the disclaimer to Claims 6 and 7 of the Holdsworth patent in suit. Claim 1, which appears on page 241, 111 Fed. (2d), reads as follows:

> "A roll comprising pieces of rock forming a portion of the active surface of the roll; and a binder of material other than said rock for holding said pieces in the desired position."

The disclaimer as to Claim 1 and other claims appears on page 242, and reads as follows:

> "Under claims 1, 2, 3, 4, 5, 6 and 8 it disclaims from the scope of said claims all rolls, if such be in law comprehended by said claims in their present form, other than paper machine rolls for operation in contact with a moist web."

In holding valid the claims as limited by the disclaimer, the Court said:

> "The disclaimer of the words 'and elsewhere' confined the patent to paper making machines. As applied to the claims, the disclaimer limited them to rolls in a paper making machine which came 'in contact with a moist web.'
>
> "A disclaimer that limits claims by exclusion of a part to a field they might in their original form have covered, is proper. *Byrne Mfg. Co.* v. *American Flange & Mfg. Co.*, 6 Cir., 87 F. 2d 783, 784, and cases there cited."

It will be seen that the roll, an element of original Claim 1, was limited by the disclaimer to "paper machine rolls," and its operation was limited by the disclaimer to contacting "with a moist web." The disclaimer of course did not incorporate in original Claim 1 a moist web as an element, but merely referred thereto in specifically limiting the field of operation of the roll to one where the roll contacted with a moist web.

Therefore, when the disclaimer to Claim 6 herein (supra, page 9) refers to the contact of the vertical depending perforated flange with metal lathing, this strictly follows the practice which was approved in the above decision.

The said opinion of the Court of Appeals for the Sixth Circuit was rendered on April 12, 1940, more than five years after the decision of this Court in the *Altoona* case.

The Court of Appeals for the Seventh Circuit in *Johnson Laboratories, Inc.* v. *Meissner Mfg. Co.*, 98 Fed. (2d) 937,

in holding valid claims of the Polydoroff patent No. 1,982,690, as to which a disclaimer had been filed, reviewed the law and stated:

> "We think the disclaimer is within the statute, that it adds no new elements, that it diminishes the scope of the claims of the patent without prejudicing the rights of anyone. *Byrne Mfg. Co.* v. *American Flange & Mfg. Co., Inc.*, 6 Cir., 87 F. 2d 783; *Dunbar* v. *Meyers*, 94 U. S. 187, 24 L. Ed. 34; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005. Consequently we shall consider the claims as limited by the disclaimer."

The claims of the Polydoroff patent with the disclaimers thereto printed in italics, appear in the footnote on page 944. Claim 1, as an example, is quoted below, in which the matter entered by disclaimer is italicized:

> "1. A compressed comminuted magnetic material having (a) individually-insulated particles and (b) a substantially constant permeability for a band of radio frequencies at least one octave wide. (c) *substantially all of the particles are capable of passing through a screen having 400 meshes to the inch* (d) *the compressed material has an apparent permeability of not less than 7,* (1) *at a frequency of from 300-1400 kilocycles:* (2) *at a magnetic intensity between 0.01 and 10 gauss* (e) *the compressed material has a resistivity of at least 10 ohms per centimeter cube.*"

Original Claim 1 broadly claimed a compressed comminuted magnetic material having individually insulated particles and a substantially constant permeability for a band of radio frequencies at least one octave wide. The disclaimer modified the claim by specifying that the particles were of a specified size and possessed various other characteristics.

The Court further stated:

> "The record indicates that the Polydoroff claim was too broad and, as constituted, included many compositions that were old. Consequently, truly to represent

his alleged invention, the patentee found it necessary to disclaim as to all such devices as were not within the specific limitations of his allegedly new teaching. In other words, if he taught anything it was the making of a core with the specific limitations appearing in the claim as affected by the disclaimer."

"His description and specifications are long and in great detail, and from an examination thereof, we conclude that the claim was not broadened by the disclaimer; that each of the specified limitations brought about by the disclaimer was sufficiently described in the application of the patent as to be embodied in the claim after disclaimer, and that those limitations are consistent and in accord with the specifications and teachings of Polydoroff."

The Court, in rendering its opinion, cited as authorities the decision of this Court in the *Altoona* case and the decision of the Court of Appeals for the Sixth Circuit in the *Byrne Mfg. Co.* case, and hence construed the said decisions as contended for in the instant case on behalf of petitioner, inasmuch as the disclaimer in the Polydoroff patent was similar to the disclaimer to Claims 6 and 7 of the Holdsworth patent.

The Court of Appeals for the Ninth Circuit in its recent decision in *Payne Furnace & Supply Co., Inc. v. Williams-Wallace Co.*, 117 Fed. (2d) 823, decided February 14, 1941, fully considered the law as to disclaimers, and particularly the decision of this Court in the *Altoona* case. The patent before the Court was No. 2,013,193 to Stadtfeld, granted September 3, 1935, for Composite Pipe Construction, as to Claims 1, 2 and 3 of which a disclaimer had been filed. In order to show the pertinency of this decision as supporting petitioner's contention that the disclaimer in the instant case is valid and not in conflict with the law as stated by this Court in the *Altoona* case, and further to show its conflict with the decision of the Court in the instant case, we here present the drawings of the said Stadtfeld patent:

Sept. 3, 1935. J. A. STADTFELD 2,013,193

COMPOSITE PIPE CONSTRUCTION

Filed Nov. 3, 1934

Fig. 1.

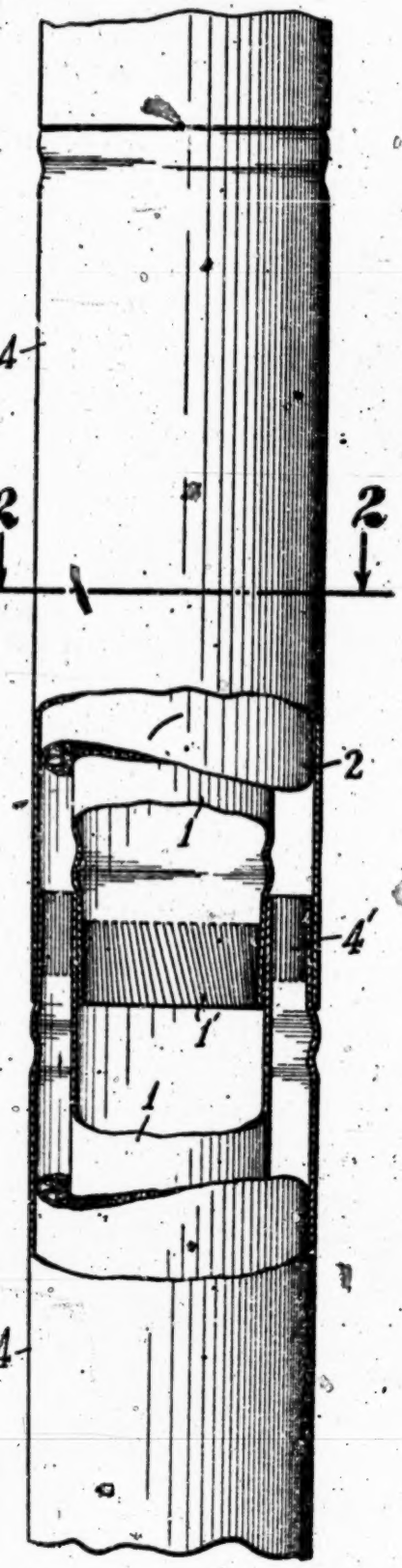


Fig. 2.

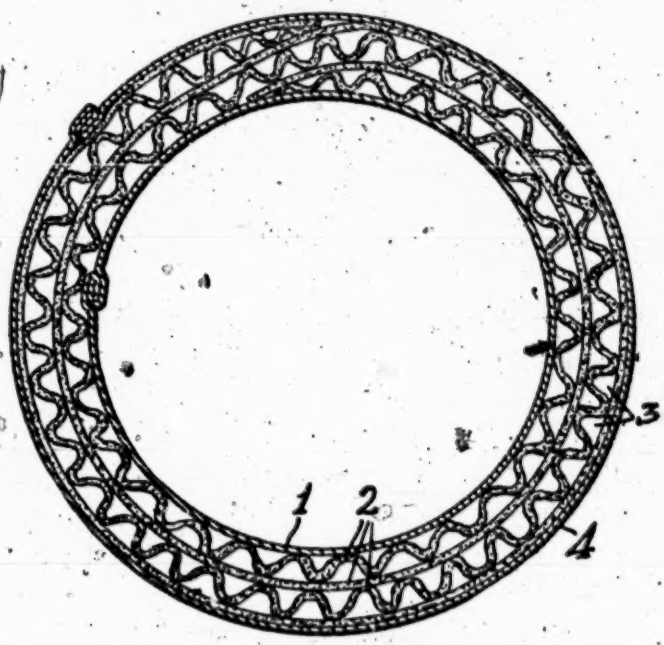
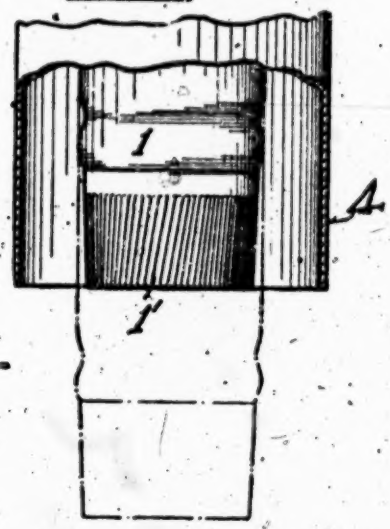


Fig. 3.



INVENTOR,
BY Jacob A. Stadtfeld
J. E. Trabucco
ATTORNEY

Claims 1, 2 and 3 of the Stadtfeld patent appear in the opinion, Claim 1 of which may be taken as illustrative, reading as follows:

> "1. A composite pipe construction comprising an outer tube, one or more layers of insulating material located around the inside surface of the said tube, and an inner tube slidably located inside the insulating material."

The disclaimer filed as to said claim reads as follows:

> "Hereby makes disclaimer of any combination of the recited elements in claims 1 and 2, except for 'composite' 'sectional' pipes for conducting 'fluids or gases of combustion' and except when 'adjacent ends of the inner and outer pipes of each section' have 'male and female' ends with the male 'end of the inner pipe' 'located adjacent the female end of the outer pipe,' and 'with the male end of an inner tube pointing downwardly and' adapted to be 'fitted inside the female end of the adjoining lower section' so that 'any condensates forming inside the said inner pipes are carried over the joint,' and 'with the male end of' the 'outer pipe of a section pointing upwardly and' adapted to be 'located inside the female end of the next higher pipe of another section,' so that 'a joint is provided which sheds any exterior moisture running downwardly over the outer pipes,' and the completed joints between 'adjacent ends' of adjoining sections 'of the inner and outer pipes' are in substantial radial alignment, and except when each string of connected pipe, outer and inner, is independently supported and 'maintained in connected relationship'; and except when the 'insulating material interposed between the two pipes' provides 'an intermediate filler' and 'has a plurality of air cells running longitudinally therethrough.'"

The facts before the Court of Appeals for the Ninth Circuit and the facts in the instant case were so analogous that the following quotations from the opinion of the said court are particularly pertinent:

> "Appellant leans heavily on the *Altoona Theatres* decision. It contends the appellee's disclaimer attempts

to import into the patent elements lacking in the original claims; and that the disclaimer is, and must of necessity be, predicated upon an admission that the combination originally claimed is invalid."

"We do not understand that the Supreme Court in the *Altoona Theatres* decision, *supra*, intended to overrule the many decisions upholding disclaimers of this character."

"After the disclaimer, as before, the combination consists of three elements, plus the functional feature of slidability. These elements, however, as modified by the disclaimer, have certain structural characteristics or limitations not mentioned in the claims."

"We are unable to read the disclaimer as attempting to do more than confine the claims to the specific environment already fixed in the specifications and drawings. By it the inventor undertakes to narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications."

Not only is the decision of this Court in the *Altoona* case construed by various Circuit Courts of Appeals consistently with the construction which petitioner urges in the instant case, and inconsistently with the decision of the lower court, but it has been similarly construed by various District Courts, including Judge Schoonmaker in *American Morgan Co.* v. *Joy Mfg. Co.*, 21 F. S. 419, 424. Judge Schoonmaker said:

"The plaintiffs further urge the court to hold the claims of the Arentzen patent invalid, because the defendant has brought into his claims a new element, *i.e.*, a particular type of endless-chain conveyor, to wit, 'a single endless chain that extends around said decks so as to lie above and below the same in a plane substantially vertical thereto.' This, the plaintiffs claim, is adding a new element to the three claims in suit, which cannot be done, under the ruling of the Supreme Court in *Altoona Publix Theatres* v. *American Tri-Ergon*

Corp. et al., 294 U. S. 477, 490, 491, 55 S. Ct. 455, 79 L. Ed. 1005. However, we cannot see that defendant has introduced a new element by its disclaimer. The endless chain was in the original specification, and, by the disclaimer, is limited to a particular type of endless chain.

"Plaintiffs also contend that the Arentzen patent is invalid, because the disclaimer defines a different invention than that of the original patent. We cannot find that the disclaimer in the instant case does that. As we view the disclaimer, it limits the claims in suit to a specific type of endless chain, thereby bringing the disclaimer within the class where a claim is limited to a specific type of the general class to which it was applied. See *Altoona Publix Theatres* v. *American Tri-Ergon Corp., supra.*"

That the above decisions are clearly in conflict with that of the lower court in the instant case is obvious, and it is submitted on behalf of petitioner that the lower court was in error in holding that Claims 6 and 7 of the Holdsworth patent in suit were rendered invalid by the disclaimer, in view of the decision of this Court in the *Altoona* case, for the following reasons: (a) the disclaimer does not add a new element to the wall construction defined in original Claims 6 and 7, and (b) it does not transform the Holdsworth patent originally for one combination "into a new and different one" for a new combination.

Point 3.

For convenient reference, Sec. 4917 (U. S. C., Title 35, Sec. 65) is quoted:

"Whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or

substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. (See R. S. secs. 973, 4922.)"

Sec. 4922 (U. S. C., Title 35, Sec. 71) supplements the foregoing statute by providing that a patentee may maintain a suit at law or equity for the infringement of any part of his patent which was *bona fide* his own, but "no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit."

Since the original disclaimer statute was enacted in 1837, numerous disclaimers have been held to be within its purview which did not eliminate complete claims but rendered more specific the patented invention by specifying that certain elements in the claims had certain characteristics. The lower Court recognized such to be the fact as follows:

> "It must, however, be admitted that before *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, the law, as settled by the lower courts (ourselves included) was otherwise, although, so far as we have found, the Supreme Court had never before discussed the question and sustained such a disclaimer against the objections we have stated; not even in *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 435, 436, which has been often cited as doing so."

The lower Court was in error in suggesting that this Court had never before passed upon a disclaimer of the character in question. This Court in *Hurlbut* v. *Schillinger*, 130 U. S. 456, 465, sustained a patent as to which a disclaimer had been filed which limited the scope of the patent without wholly eliminating the claim. This Court said:

> "We are of opinion that the proper construction of the reissued patent is, that the invention consists in dividing the pavement into blocks, so that one block can be removed and repaired without injury to the rest of the pavement, the division being effected by either a permanent or a temporary interposition of something between the blocks. Concrete pavement had been laid before in sections, without being divided into blocks. The effect of the disclaimer was to leave the patent to be one for a pavement wherein the blocks are formed by interposing some separating material between them. To limit the patent to the permanent interposition of a material equivalent to tar-paper, would limit the actual invention." . . . "The disclaimer took out of the first claim of the reissue only so much thereof as claimed a concrete pavement made of the plastic material laid in detached blocks, without interposing anything in the joints in the process of formation, leaving that claim to be one for such a pavement laid in detached blocks, when free joints are made between the blocks, by interposing permanently or temporarily between them, in the process of their formation, tar-paper or its equivalent."

Furthermore, this Court in the *Altoona* case, in a footnote on page 490 (294 U. S.), stated:

> ". . . The use of the disclaimer has been upheld where the elimination from the patent of the matter not relied upon did not operate to enlarge the monopoly of the patent, but narrowed it, as . . . by limiting the claim to a specific type of the general class to which it was applied."

In its said decision, this Court further stated regarding the disclaimer:

". . . the statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, . . ."

In *Sessions* v. *Romadka*, 145 U. S. 29, 40, this Court stated:

"The power to disclaim is a beneficial one, and should not be denied, except where it is resorted to for a fraudulent and deceptive purpose."

In *Triplett* v. *Lowell*, 299 U. S. 638, 645, this Court said:

"The disclaimer statute is remedial, and intended for the protection of both the patentee and the public."

The Court of Appeals for the Ninth Circuit in *Payne Furnace & Supply Co., Inc.* v. *Williams-Wallace Co.*, 117 Fed. (2d) 823, said:

"It has many times been said that the disclaimer statute is remedial. In exercising the privilege granted by it the patentee is entitled to fair and liberal treatment so long as he imports no new element into his claims or does not attempt to broaden his invention beyond the conception as originally described."

". . . We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed. But no one has been prejudiced by the disclaimer. An innocuous gesture of this sort ought not compel the penalizing of the inventor by striking down a meritorious invention. That course, we think, would pervert the benign purpose of the statute, converting it from a shield in the hands of the inventor to a sword in the possession of his adversary."

It is submitted that the lower Court was in error in interpreting the decision of this Court in the *Altoona* case as denying the beneficial provisions of the disclaimer statute to a patentee who limits his monopoly, not by eliminating an entire claim, but by specifying that certain elements in

an original claim in his patent possess certain structural characteristics.

Conclusion.

For the reasons above stated, it is urged that the petition for writ of certiorari be granted, especially in view of the recognition by the lower Court that its decision is not consistent with those in other circuits, and its statement that "the Supreme Court alone can declare what is the present law on the subject."

Respectfully submitted,

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ASHER BLUM,
Counsel for Petitioner.